

Remarks

Claims 1-20 are pending in the present application. Claims 1-5, 7-8, and 10-20 stand rejected under 35 USC 103(a) for obviousness over U.S. Patent No. 5,692,073 to Cass. Claim 6 stands rejected under 35 U.S.C §103(a) over Cass in view of U.S. Patent No. 5,913,542 to Belucci et al. and further in view of U.S. Patent No. 6,203,069 in view of Outwater et al. Claim 9 stands rejected under 35 U.S.C §103(a) in view of over Cass in view of U.S. Patent No. 6,249,716 to Edens et al. Applicant respectfully requests allowance of all pending claims.

Independent claim 1 recites *associating at least a portion of a first communication together with an identifier code on a substrate, changing the first communication on a substrate to form a second communication which is different from the first communication, and storing the second communication in a database*. On page 3 of the Office Action, it is stated that col. 8, lines 20-29 of Cass allegedly disclose storing a marked document in a database. Applicant disagrees.

Col. 8, lines 20-29 refer to a "document instance" which comprises a copy, printout or other rendering of a known document for which an original or other reference version is stored in a database. Accordingly, Cass clearly discloses a database of the original documents but fails to disclose or suggest any storage of a "document instance" or marked document within a database. As identified on pages 2-3 of the Office Action, the reference document serves as an original document image without marks. Col. 8, lines 20-29 disclose that the reference document (without marks) may be stored within a database. Cass is silent regarding any storage of marked document instances within a database. Further, such interpretation of Cass is nonsensical inasmuch as Cass merely identifies marks on the document instance, locates active elements and performs any desired action indicated by the user's mark. There is no need for the document instance to be stored within a database because Cass is directed towards a printer user interface (PUI) only concerned with interpreting marks of the document instance and performing desired actions. Applicant refers the Examiner to teachings in col. 10, lines 12-18 wherein it is stated that a marked

Serial No. 09/325,910

Case No. 10990146-1

Amendment C

document instance is used to provide an index into a database so to retrieve a corresponding known reference document. Cass fails to disclose or suggest changing a first communication forming a second communication and storing the second communication within a database as claimed. Positively-recited limitations of claim 1 are not shown nor suggested by the prior art and claim 1 is allowable for at least this reason.

Claim 1 stands rejected under 103 for obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed.).

Applicant has identified limitations of claim 1 which are not shown nor suggested by Cass. Accordingly, the 103 rejection is improper for at least this reason. In addition, there is no motivation to modify Cass to arrive at Applicant's claim 1 method. Cass is directed towards a printer user interface for identifying marks on a page and taking appropriate action using active elements. There is absolutely no purpose or motivation to modify Cass to store the second communication in the database as claimed and the only motivation can result from improper utilization of Applicant's disclosure. There is no motivation in support of the obviousness rejection and claim 1 is allowable for this additional reason.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to claim 2, it is recited that the changing the first communication on the substrate comprises removing a portion of the substrate having a portion of the first communication thereon. Cass and the other prior art references are devoid of any removal of a portion of the substrate as

claimed. Page 4 of the Office Action identifies Cass teachings which allegedly disclose limitations of claim 2, however, no teachings are identified as allegedly disclosing the claimed removal. Claim 2 recites limitations not shown nor suggested in the art and claim 2 is allowable for at least this reason.

Turning to independent claim 7, it is alleged on page 5 of the Action that Cass teaches storing multiple document instances in a database relying upon the teachings of col. 8, lines 20-29, discussed above. The Action states that *similar* documents are indexed together. As clearly set forth in cols. 8 and 10 and other teachings of record, Cass merely discloses storage of different reference documents in a database. Mere storage of different reference documents in the database fails to disclose or suggest the specifically claimed providing a database having multiple versions of a document stored therein as data sets and the multiple versions having a common document specific code and different version specific codes. Cass merely discloses storage of reference documents which do not teach or suggest multiple versions of a document as claimed. Further, Cass does not disclose and has no need to provide the multiple versions with a common document specific code inasmuch as there is no common document or multiple versions of a common document provided. It further follows Cass fails to disclose or suggest the multiple versions having different version specific codes as claimed. Numerous limitations of claim 7 are not disclosed nor suggested and claim 7 is allowable for at least this reason.

Cass also fails to disclose or suggest the claimed extracting of the document specific code and version specific code from a first version of the document and the processor being configured to extract at least a portion of the second version from the data set as further defined in claim 7. Applicant notes the Office Action identifies numerous Cass teachings which allegedly disclose limitations of claim 7 but fails to identify any teachings which allegedly disclose extraction of a version specific code from one version of a document and extracting at least a portion of another version of the document. Such limitations are not shown nor suggested by Cass. Applicant respectfully requests identification of prior art teachings which allegedly disclose at least the identified limitations of Applicant's claims in accordance with the CFR in a *non-*

Final Action if claim 7 is not allowed. In particular, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicants respectfully request clarification of any rejections in a non-Final Action with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2).

There is no motivation to modify the reference teachings of Cass to arrive at Applicant's claim 7 invention. The 103 rejection of claim 7 is improper for at least this additional reason.

The claims which depend from independent claim 7 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to claim 10, the method further comprises sending a prompt to a user when the processor detects that multiple versions of the document are stored, and providing input from the user to indicate which of the multiple versions is to have at least a portion extracted from the database. Page 12 of the Office Action states Cass with reference to col. 8 teaches presenting an index of versions of similar documents to a user and through the use of active elements, the user is able to indicate which portions require some sort of action including extraction. The Examiner is mistaken. Referring to the identified teachings of col. 8, it is clearly stated that the document instance image is used to generate an index into the stored collection of documents by computer 100 under the control of processor 105 as set forth in col. 7, lines 57-60. The processor 105 uses the document instance to generate an index to retrieve a stored reference document. Applicant refers the Examiner to additional details at col. 10, line 27 - col. 11, line 26 regarding indexing and

Serial No. 09/325,910
Case No. 10990146-1
Amendment C

identifying a reference document with absolutely no user input. The disclosure of Cass in no fair interpretation provides a database having multiple versions of a document, or provides any disclosure of prompting a user upon detection of the multiple versions. The teachings of Cass with respect to active elements refer to actions taken by the processor 105 responsive to interpreting the user's mark. The use of active elements of Cass does not disclose extraction of a portion of a version responsive to a user input but refers to actions taken by processor 105 responsive to interpretation of a user mark. Numerous limitations of claim 10 are not shown nor suggested by the prior art and claim 10 is allowable. Applicant requests a non-Final Action to correct the deficiencies of the pending rejection of claim 10 if such claim is not found to be allowable in the next Action.

Referring to claim 13, the prior art fails to disclose or suggest storage of *multiple versions of a communication in a database*. The teachings in col. 8 merely refer to storage of reference documents and fail to disclose multiple versions of a communication. Cass is devoid of teaching or suggesting storage of a marked document image in a database as alleged on page 9 of the Action. Limitations of claim 13 are not disclosed nor suggested and claim 13 is allowable for at least this reason. Cass fails to disclose or suggest saving the second version of the communication to the database and *associated with a second identifier code*. Cass further fails to disclose using *first and second identifier codes* to retrieve and compare first and second data sets corresponding to respective versions of a communication, or *prompting a user to select which of multiple versions is to be displayed*. The identified teachings on page 9 of the Action of comparing the document instance with respect to the reference document fails to disclose or suggest comparison of data sets of multiple versions of a communication for the claimed retrieval. To the contrary, Cass uses indexing to retrieve the reference document and uses comparison to identify marks as set forth in col. 8, lines 54-60. Numerous limitations of claim 13 are not shown nor suggested by Cass and claim 13 is allowable for at least this reason.

Further, no prior art teachings are identified as allegedly disclosing *prompting of the user to select which of multiple versions is to be displayed*. Pursuant to the CFR, Applicant requests identification of prior art teachings in a Non-Final Action which allegedly correspond to at least the above-identified limitations if claim 13 is not found to be allowable.

There is no motivation to modify the reference teachings of Cass to arrive at Applicant's claim 13 invention. The 103 rejection of claim 13 is improper for at least this additional reason.

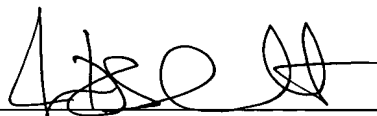
The claims which depend from independent claim 13 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Applicant requests allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,
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Serial No. 09/325,910
Case No. 10990146-1
Amendment C